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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,460	06/29/2001	Joseph G. Gatto	23449-013	7177
29315	7590	03/25/2005	EXAMINER	
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC 12010 SUNSET HILLS ROAD SUITE 900 RESTON, VA 20190			SUBRAMANIAN, NARAYANSWAMY	
		ART UNIT		PAPER NUMBER
				3624

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/893,460	GATTO, JOSEPH G.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Narayanswamy Subramanian	3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 29 June 2001.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-3, 6-40 is/are rejected.  
7)  Claim(s) 4 and 5 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 23 October 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/13/03.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

1. Original claims 1-40 have been examined. The rejections are stated below.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. Claim 40 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

Claim 40 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the method claim as presented does not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

"A computer implemented method for monitoring analysts' estimates ---", or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 43 of U.S. Patent Application No. 10/119,082. Although the conflicting claims are not identical, they are not patentably distinct from each other

because they recite the means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claim 1 recite “the means for storing on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made; means for analyzing the current estimate data and determining when one or more alert conditions are satisfied” that are listed in claim 43 of Gatto ('082). The alert condition is an error metric used to calculate performance. The means for issuing an alert when at least one predetermined alert condition is satisfied for at least one analyst, not cited in the '082 application would have been obvious to one with ordinary skill in the art. The issuance of alert would have allowed the user to take appropriate action in response to the alert.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 6-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundgren (US Patent 5,608,620) in view of Curtis et al (US Patent 6,208,720 B1).

With reference to claims 1 and 40, Lundgren teaches a system and method comprising: means for storing on a per analyst basis, current estimate data for a plurality of analysts, the data

including at least an estimate amount and when the estimate was made and means for analyzing the current estimate data (See Lundgren Abstract, Figure 1, Col 1 lines 21-50, Claim 1).

Lundgren does not explicitly teach means for determining when one or more alert conditions are satisfied and means for issuing an alert when at least one predetermined alert condition is satisfied for at least one analyst.

Curtis teaches the means for determining when one or more alert conditions are satisfied and means for issuing an alert when at least one predetermined alert condition is satisfied (See Curtis Abstract and Claim 1)

Both Lundgren and Curtis are concerned with providing appropriate information to a decision maker. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Curtis to the disclosure of Lundgren. The combination of the disclosures taken as a whole suggests that users would have benefited from being informed about abnormal conditions so as to take appropriate actions in response to the notification of abnormal conditions.

With reference to claims 2, 3 and 6-39 the features in these claims are old and well known in the art. It would have been obvious to include these features to the combined disclosures of Curtis and Lundgren. The combination of the disclosures taken as a whole suggests that users would have benefited from being informed about abnormal conditions so as to take appropriate actions in response to the notification of abnormal conditions.

***Allowable Subject Matter***

8. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian  
March 19, 2005



Jagdish N. Patel  
Primary Examiner